

REMARKS

Responsive to the Office Action dated April 7, 2004, Applicant hereby makes the following response. The present application was filed on February 28, 2002 and included Claims 1-62 of which Claims 21-62 were withdrawn pursuant to a restriction requirement December 31, 2003. In this Amendment, Applicant has amended Claims 1, 16 and 19. Accordingly, Claims 1-20 with Claim 1 being independent are currently pending for prosecution.

I. Specification Objections

The specification was objected to and correction required because of two informalities. Applicant has amended the specification to comply with this requirement and also to correct all minor errors Applicant has become aware of in the specification. Accordingly, Applicant respectfully requests withdrawal of the objection to the disclosure.

II. Claim Objections

Claims 1-20 were objected to and correction required because of two informalities. Applicant has amended Claims 1 and 16 to comply with this requirement. Accordingly, Applicant respectfully requests withdrawal of the claim objections.

III. The § 112 Rejection

Claims 6, 19 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended Claims 1, 6 and 19 to provide proper antecedent basis for "said wiping surface" and "said temperature." Accordingly, Applicant respectfully requests withdrawal of this rejection.

IV. The § 102 Rejections

A. Rejection of Claims 1-3 and 7-11 over Talieh

Claims 1-3 and 7-11 have been rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,176,992 to Talieh. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Applicant respectfully submits that Talieh does not anticipate Applicant's invention as claimed because Talieh fails to disclose each and every element and limitation of the claims at issue. In particular, Talieh fails to disclose a second electrode disposed adjacent to a wiper, the electrode having at least one venting hole disposed therein wherein the venting hole is configured to vent gas from the surface of the object to be machined. Accordingly, Claims 1-3 and 7-11, as amended, are not anticipated because Talieh fails to teach every element and limitation of these claims.

B. Rejection of Claims 1-8, 10-11, and 14 over Doan

Claims 1-8, 10-11, and 14 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,582,281 to Doan et al.. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Applicant respectfully submits that Doan does not anticipate Applicant's invention as claimed because Doan fails to disclose each and every element and limitation of the claims at issue. In particular, Doan fails to disclose a second electrode disposed adjacent to a wiper, the electrode having at least one venting hole disposed therein wherein the venting hole is configured to vent gas from the surface of the object to be machined. Accordingly, Claims 1-8, 10-11, and 14, as amended, are not anticipated because Doan fails to teach every element and limitation of these claims.

V. The § 103(a) Rejections

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Rejection of Claims 12 and 13 over Doan

Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,582,281 to Doan et al.. For the following reasons, Applicant respectfully submits that the present invention is not obvious under 35 U.S.C. § 103(a) and requests reconsideration and withdrawal of this rejection.

Doan does not teach or suggest the claimed invention. In particular, Doan does not teach or suggest a second electrode disposed adjacent to a wiper, the electrode having at least one venting hole disposed therein wherein the venting hole is configured to vent gas from the surface of the object to be machined. Thus, Doan fails to teach or suggest all the elements of Applicant's claims. Accordingly, independent Claim 1, as amended, and the claims depending therefrom are nonobvious under 35 U.S.C. § 103(a).

B. Rejection of Claims 15-18 over Doan in view of Taylor

Claims 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Doan et al. in view of U.S. Patent No. 6,558,231 to Taylor. For the following reasons, Applicant respectfully submits that the present invention is not obvious under 35 U.S.C. § 103(a) and requests reconsideration and withdrawal of this rejection.

As discussed above, Doan does not teach or suggest a second electrode disposed adjacent to a wiper, the electrode having at least one venting hole disposed therein wherein the venting

hole is configured to vent gas from the surface of the object to be machined. Similarly, Taylor fails to teach or suggest this same element of Applicant's invention.

Prima facie obviousness requires that there must be a reasonable expectation of success when prior art is modified or combined. In the present application, there is no reasonable expectation of success in achieving the present invention as claimed when the cited references are combined. As discussed above, neither Doan nor Taylor contains all the elements of independent Claim 1, as amended. Unless all the elements are taught by the reference, there can be no success in modifying them. Accordingly, independent Claim 1 and its dependent claims 15-18 are nonobvious under 35 U.S.C. § 103(a).

C. Rejection of Claims 19 and 20 over Doan in view Shimomura

Claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Doan et al. in view of U.S. Patent No. 5,922,620 to Shimomura et al.. For the following reasons, Applicant respectfully submits that the present invention is not obvious under 35 U.S.C. § 103(a) and requests reconsideration and withdrawal of this rejection.

As discussed above, Doan does not teach or suggest a second electrode disposed adjacent to a wiper, the electrode having at least one venting hole disposed therein wherein the venting hole is configured to vent gas from the surface of the object to be machined. Similarly, Shimomura fails to teach or suggest this same element of Applicant's invention.

Prima facie obviousness requires that there must be a reasonable expectation of success when prior art is modified or combined. In the present application, there is no reasonable expectation of success in achieving the present invention as claimed when the cited references are combined. As discussed above, neither Doan nor Shimomura contains all the elements of independent Claim 1, as amended. Unless all the elements are taught by the reference, there can

be no success in modifying them. Accordingly, independent Claim 1 and its dependent claims 15-18 are nonobvious under 35 U.S.C. § 103(a).

VI. Conclusion

Applicant respectfully requests withdrawal of the rejections and believes that the claims as amended represent allowable subject matter. However, if the Examiner desires, the applicant is ready for a telephone interview to expedite prosecution. As always, the Examiner is free to call the undersigned at 816.460.2516. Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct any such fees from Deposit Account No. 19-3140.

Respectfully submitted,

SONNENSCHN NATH & ROSENTHAL LLP

By 

Lara Dickey Lewis, Reg. No. 48,161
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
816-460-2516 (telephone)
816-531-7545 (facsimile)

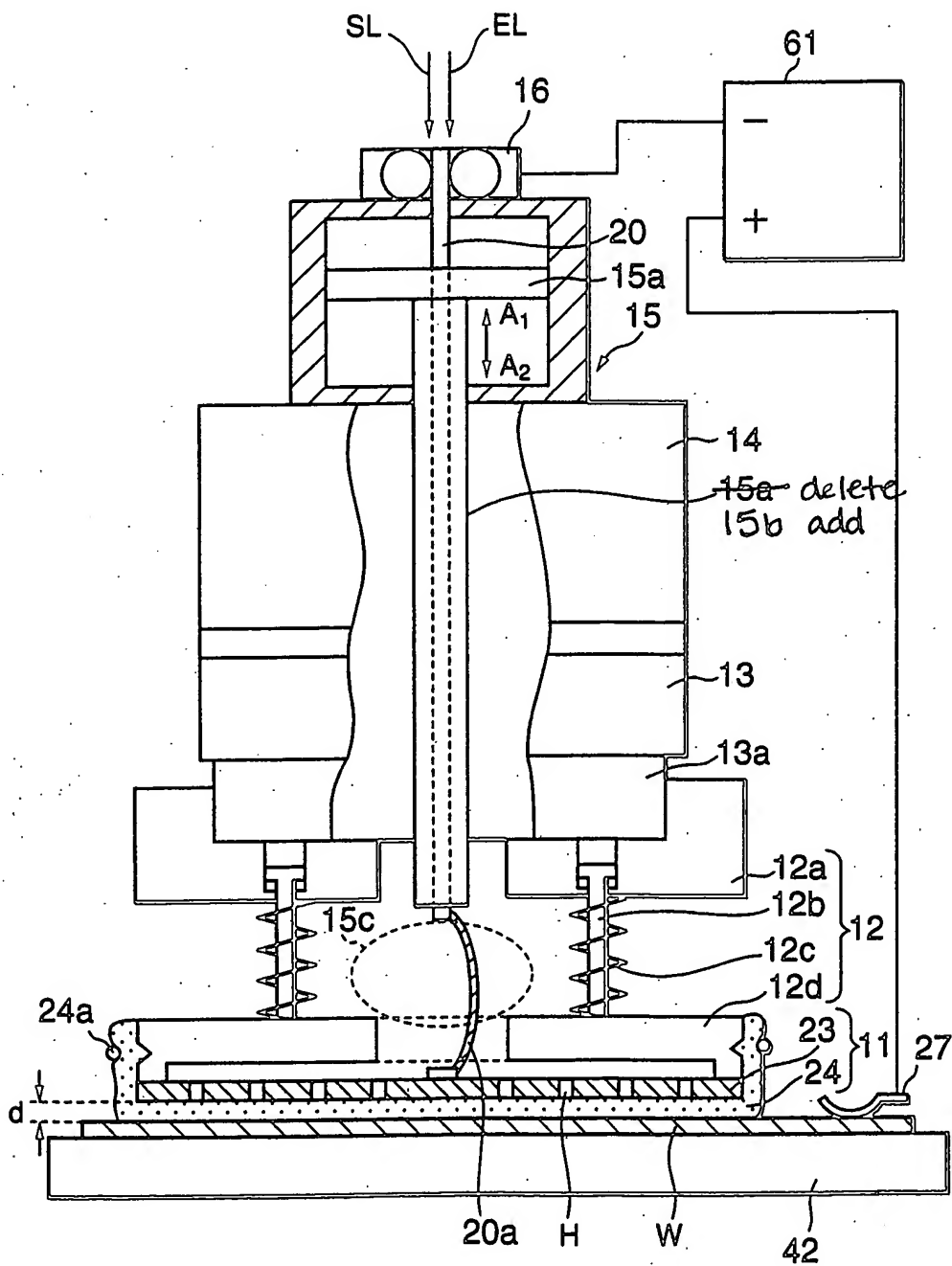
ATTORNEYS FOR APPLICANT



Annotated Sheet Showing Changes

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FIG. 14



Annotated Sheet Showing Changes

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FIG. 17A

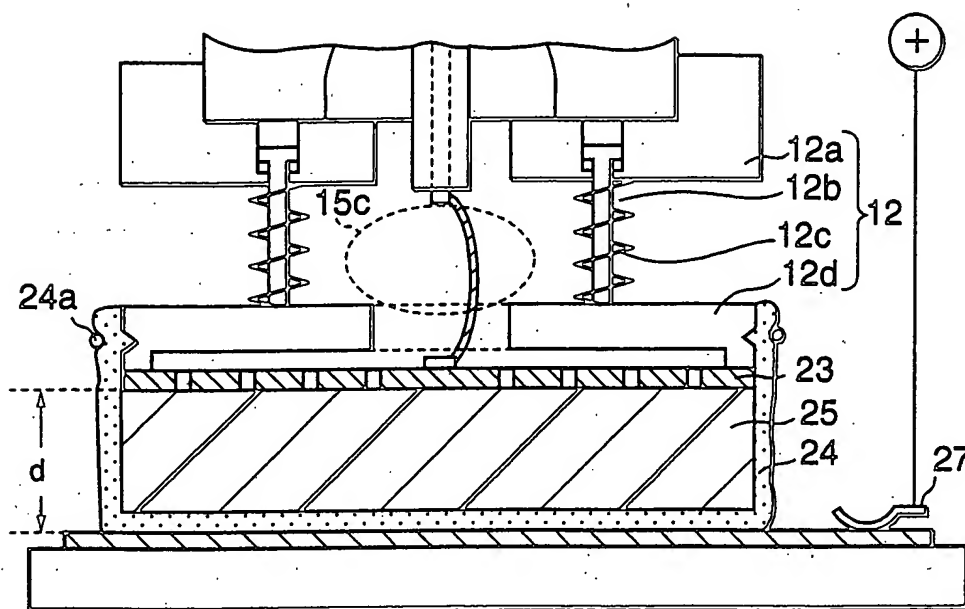


FIG. 17B

